

## **REMARKS**

The present Office Action addresses and rejects claims 1-7. Applicants respectfully request reconsideration in view of the amendments and remarks herein.

### ***Rejections Pursuant to 35 U.S.C. § 103***

#### **Pegg and Hallac**

Claims 1 and 3-6 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over U.S. Patent 4,649,918 to Pegg et al. ("Pegg") in view of U.S. Patent 3,605,721 to Hallac ("Hallac"). The Examiner asserts that Pegg teaches the claimed invention except for "at least one recess adjacent the distal end." The Examiner thus relies on Hallac to teach the claimed recess. Applicants respectfully disagree.

One having ordinary skill in the art would not be motivated to modify the bone core removing tool of Pegg to include a tube having at least one recess adjacent the distal end. The Examiner asserts that it would have been obvious to modify the device of Pegg to include a plurality of recesses, as taught by Hallac, to "allow the capturing of a bone plug." As an initial matter, the recesses taught by Hallac do not "capture" a bone plug. As explained at col. 3, lines 33-39 of Hallac, the distal end of the inner needle (16) of the Hallac device includes rectangular slits or openings that are defined by bars (50). In use, the inner and outer needles (12, 16) of the Hallac device are rotated relative to each other causing the bars (50) to twist and collapse the weakened wall portion of the inner needle (16). Further rotation of the needles (12, 16) is effective to *sever the bars (50) thereby trapping a specimen of tissue*. (Hallac, col. 4, lines 1-8). In other words, it is the *bars (50)* of the Hallac device that "capture" a specimen – not the openings, as asserted by the Examiner. Thus, one skilled in the art would not be motivated to modify Pegg to include a plurality of recesses to capture a bone plug because Hallac does not teach or even suggest recesses for such a purpose.

Moreover, there is no advantage to modifying the tool (20) of Pegg to include at least one recess adjacent the distal end to capture a bone plug because Pegg already discloses features specifically designed to cut and capture a bone sample. The strongest rationale for combining references is a recognition that some advantage of expected beneficial result would be produced by

the combination. (See MPEP §2144). As explained at col. 2, lines 47-56, the removal tool (20) includes three teeth (34, 36, 38) positioned just inside the cutting edge (26). Pegg goes on to explain that as the tool (20) is rotated, the bone core is forced to break loose from the surrounding bone at the cutting edge (26) and the teeth (34, 36, 38) are embedded into the bone core such that the bone core is extracted along with the tool (20) upon removal. Since Pegg specifically discloses the cutting edge (26) and the teeth (34, 36, 38) to cut and capture a bone core, there is no need to modify Pegg to include a recess to accomplish the same. Even further, modifying Pegg to include a recess, as taught by Hallac, would complicate the design of the Pegg device, as Hallac teaches a tool having not one but two tubular structures – the recess being formed on an inner needle (16) that is received by an outer needle (12). Pegg only discloses one tubular structure, thus making it difficult to modify to include a recess as taught by Hallac, at least not without completely redesigning the device of Pegg. Accordingly, independent claim 1, as well as claims 2-7 which depend directly or indirectly therefrom, distinguish over Pegg and Hallac, taken alone or combined, and represent allowable subject matter.

Pegg, Hallac, and Stavropoulos

Claim 2 is rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Pegg in view of Hallac and further in view of U.S. Patent 4,142,517 to Stavropoulos et al. (“Stavropoulos”). The Examiner asserts that Pegg and Hallac teach the claimed invention except for the “sheath mated to the tube and including one or more markings.” As explained above, one skilled in the art would not be motivated to modify Pegg in view of Hallac. Stavropoulos does not remedy the deficiencies of Pegg and Hallac as Stavropoulos is merely relied upon to teach a sheath and likewise fails to provide the requisite motivation. Accordingly, claim 2 is allowable at least because it depends from an allowable base claim.

Pegg, Hallac, and Torrie

Claim 7 is rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Pegg in view of Hallac and further in view of U.S. Patent 6,358,253 to Torrie et al. (“Torrie”). The Examiner asserts that Pegg and Hallac teach the claimed invention except for “a bone plug formed from articular cartilage and underlying bone tissue.” As explained above, one skilled in the art would not be motivated to modify Pegg in view of Hallac. Torrie does not remedy the deficiencies of Pegg and

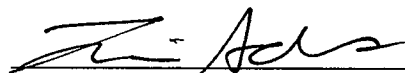
Hallac as Torrie is merely relied upon to teach a bone plug formed from articular cartilage and underlying bone tissue and likewise fails to provide the requisite motivation. Accordingly, claim 7 is allowable at least because it depends from an allowable base claim.

***Conclusion***

In conclusion, Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested.

Respectfully submitted,

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